

REMARKS

The Office Action mailed August 16, 2005 has been received and reviewed. Claims 57-89 are pending and are rejected in view of a newly cited reference. Claims 57 and 79 are amended. For the reasons stated herein, the Applicants submit that the claims are in condition for allowance.

Reference to Abstract

The Examiner notes again the written requirements of an Abstract. The Applicants have previously amended the Abstract responsive to the Examiner's repeated reminder. Withdrawal of the requirement or reference to a proper Abstract is requested.

Rejection Of Claims 57, 58, 60-62, 64-71, 74-76 and 78 Under 35 U.S.C. § 103(a)

Claims 57, 58, 60-62, 64-71, 74-76 and 78 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop in view of Badger and Sues. The Examiner repeats the prior rejection based on Bishop and Badger, and adds that Sues is analogous art which teaches a plurality of protected devices each having the ability to shut off the automobile if any of the devices is not authentic, thereby making each component essential to operating the vehicle. The Examiner asserts that Sues teaches the concept that each element "has the power" to disable the vehicle if not authentic and by having such power, the operation of the security system to disable the vehicle is greatly increased since the potential thief cannot merely disable a single authentication device in one component. The Examiner contends that it would have been obvious to one of skill in the art to have used the authentication elements of Bishop-Badger, namely the receiver and comparison elements, in each component necessary to the operation of the vehicle since, as suggested by Sues, it would greatly increase the ability to disable the vehicle and prevent theft. The rejection is traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

No *prima facie* case of obviousness is established in the application of Bishop, Badger and Sues as the Examiner contends because, first and foremost, not all the elements of the claims are found in the cited references.

The claims require a method where a device has a plurality of electronic operating components, each being essential to use or operation of the device. As previously argued, neither Bishop nor Badger teach that claim requirement. The Examiner now asserts that Sues provides that element of the claim by teaching or suggesting that each component becomes essential to operation because if the component is stolen or not authentic to the vehicle the vehicle won't start. Respectfully, Sues does not teach what is claimed as the Examiner contends. Sues does not teach that each stolen component is an electronic operating component, nor does Sues teach that each component is essential to intended or conventional use or operation of the device as claimed. Rather, Sues describes at column 2, lines 4-7, that, for example, theft of a left front fender of the vehicle which will disable the car from which it was stolen as well as disable the car into which the stolen part is placed. Respectfully, no one skilled in the art would misinterpret a left front fender to be an electronic operating component of a car, let alone that a left front fender is essential to the intended or conventional use or operation of the car. A car can be operated or used without the left front fender.

More to the point, the instant claims do not require that a device be outfitted with

components that may become electronic operating components or which evolve into components essential to operation of the device merely because the component is stolen as the Examiner contends that Sues teaches. The present invention is not directed to providing a device with a plurality of components to increase the ability to disable the device as the Examiner asserts is the motivational objective of Sues. Rather, the claims require methods of disabling a device where a device comprises electronic operating components that exist as part of the device and are essential to operation of that device. Sues provides no such teaching. The teaching of Sues is unrelated and has no bearing on the claimed methods. Sues is directed to preventing the theft and/or unauthorized use of stolen components, not to a means for preventing theft of the device itself.

Additionally, the claims require use of electronic operating components that are each capable of receiving a radio signal from an air-borne source. That claim element is not taught or suggested by Sues, nor by Bishop or Badger as previously argued. The claims further require that each electronic operating component be in electronic communication with the plurality of other electronic operating components to determine if any other electronic operating component has received a radio signal from an air-borne source. That claim element is not taught or suggested by Sues, nor by Bishop or Badger as previously argued.

There is, and can be, no motivation or purpose found in the references to combine the references as suggested by the Examiner because there is a failure among all the references to teach all the elements that are claimed. Further, there is no reasonable expectation found in any of the references that any such combination will result in that which is claimed. Therefore, the references, even if combined, fail to teach or suggest what is claimed, and a *prima facie* case of obviousness is not established. The claims are not obviated for that reason.

Rejection Of Claim 59 Under 35 U.S.C. § 103(a)

Claim 59 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop, Badger and Sues, as applied to claim 57, and further in view of Besharat. The rejection is traversed for the reasons stated above with respect to the failure to establish a *prima facie* case of obviousness of claim 57. Besharat teaches a means for saving the battery life of a battery operated device by providing out-of-range battery savings, and provides no relevant teaching to claim 59. Even if Besharat were combinable with Bishop, Badger and Sues, the combination would still fail to establish a *prima facie* case of obviousness with respect to claim 59. Claim 59 is not obviated, therefore.

Rejection Of Claims 63 and 77 Under 35 U.S.C. § 103(a)

Claims 63 and 77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Badger, Bishop and Sues as applied to claim 57 and further in view of Hertel. The rejection is traversed for the reasons stated above with respect to the failure to establish a *prima facie* case of obviousness of claim 57 in view of Bishop, Badger and Sues. Hertel teaches a means of disabling a vehicle upon the exceeding of a set boundary or upon entry into unauthorized territory. Even if combinable with Bishop, Badger and Sues, the resulting combination would still not obviate claims 63 and 77 because they fail, in combination, to teach or suggest the elements of the claimed invention.

Rejection Of Claims 72 and 73 Under 35 U.S.C. § 103(a)

Claims 72 and 73 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop, Badger and Sues as applied to claim 57, and further in view of Szarka. The rejection is traversed for the reasons stated above with respect to the failure to establish a *prima facie* case of obviousness of claim 57 in view of the failure of Bishop, Badger and Sues to teach all of the elements of the claims. Further, Szarka teaches a

system where a plurality of non-air borne transmitters transmit a continuous radio signal received by a vehicle such that only upon discontinuity of the radio signal is the vehicle disabled. Even if Szarka were combinable with Bishop, Badger and Sues, the combination of references would still not teach all of the claimed elements, or provide motivation for the combination to thereby obviate that which is required by claims 72 and 73. Claims 72 and 73 are not obviated therefore.

Rejection Of Claims 79-84 Under 35 U.S.C. § 103(a)

Claims 79-84 are rejected as being unpatentable over Bishop in view of Badger and Sues. The Examiner repeats the prior rejection with respect to the respective teachings of Bishop and Badger, and adds that Sues teaches a plurality of devices each having the ability to shut off the automobile if any one of the devices is not authentic, as stated previously. Again, the Examiner contends that it would have been obvious to have used the authentication elements of Bishop-Badger in each component necessary to operation of the vehicle since Sues suggests that it would greatly increase the ability to disable the vehicle and prevent theft.

The rejection is traversed for the reasons set forth above with respect to claim 57; namely that the combined references fail to establish a *prima facie* case of obviousness because they fail to teach all of the claimed elements and lack any motivation for the combination. Claim 79, like claim 57, requires a method where a device has a plurality of electronic operating components, each being essential to use or operation of the device. As previously submitted, neither Bishop nor Badger teach that claim requirement, and the assertion that Sues teaches that element is, respectfully, insupportable. Sues does not teach that each stolen component is an electronic operating component, nor does Sues teach that each component is essential to the intended or conventional use or operation of the device as claimed.

To reiterate the above argument, claim 79 does not require that a device be outfitted with components that may become electronic operating components or which

evolve into components essential to operation of the device merely because the component is stolen as the Examiner contends that Sues teaches. Claim 79 requires a method of disabling a device where a device comprises electronic operating components that exist as part of the device and are essential to operation of that device, and Sues provides no such teaching. As stated previously, the teaching of Sues is unrelated and has no bearing on the claimed methods because Sues is directed to preventing the theft and/or unauthorized use of stolen components, not to a means for preventing theft of the device itself.

Claim 79 requires use of electronic operating components that are each capable of receiving a radio signal from an air-borne source, which is not taught or suggested by Sues, Bishop or Badger. Claim 79 also requires that each electronic operating component be in electronic communication with the plurality of other electronic operating components to determine if any other electronic operating component has received a radio signal from an air-borne source, which is not taught or suggested by Sues, Bishop or Badger. For the reasons stated above with respect to claim 57, there is, and can be, no motivation or purpose found in the references to combine the references as suggested by the Examiner to obviate claims 79-84 because there is a failure among all the references to teach all the elements that are claimed. There is no reasonable expectation found in any of the references that any such combination will result in that which is claimed. Therefore, the references, even if combined, fail to teach or suggest what is required by claims 79-84 and a *prima facie* case of obviousness is not established. The claims are not obviated therefore.

Rejection Of Claims 85, 87 and 88 Under 35 U.S.C. § 103(a)

Claims 85, 87 and 88 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop, Badger and Sues as applied to claims 79 and 80, and further in view of Kaish. The Examiner repeats the prior rejection. The rejection is traversed for the same reasons stated previously with respect to the failure to establish a *prima*

facie case of obviousness of claim 79 in view of the failure of Bishop, Badger and Sues to teach all of the elements of the claim. Further, Kaish discloses a method for rendering a device inoperative only after the occurrence of a disabling event (see column 3, lines 55-56). Since the claims do not recite a two-step disablement and inoperative structure or process, Kaish, even if combinable with Bishop, Badger and Sues, would not obviate claims 85, 87 and 88.

Rejection Of Claims 86 and 89 Under 35 U.S.C. § 103(a)

Claims 86 and 89 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop, Badger and Sues as applied to claim 79, and further in view of Rohrbach. The Examiner repeats the prior rejection. The rejection is traversed for the same reasons stated previously with respect to the failure to establish a *prima facie* case of obviousness of claim 79 in view of the failure of Bishop, Badger and Sues to teach all of the elements of the claims. Rohrbach, additionally, fails to teach a disabling system comprising a plurality of intercommunicating components as claimed. The combination of Rohrbach with Bishop, Badger and Sues cannot obviate claims 86 and 89.

CONCLUSION

The Applicants submit that claims 57-89 present patentable subject matter. Reconsideration and allowance are requested.

Respectfully submitted,



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